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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD L. KULP, GILI MENDEL, JEFFREY D. MYERS, REBECCA J. SCHALLER, GUNTURI SRIMANTH, PETER A. WALKER, and JOSEPH R. WINCHESTER

Appeal 2009-005388
Application 10/720,804
Technology Center 2100

Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and JEAN R. HOMERE, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

The Appellants appeal under 35 U.S.C. § 134(a) from the Final Rejection of claims 1-27, 30 and 32. The claims 28-29 and 31 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

I. STATEMENT OF THE CASE

The Invention

The invention at issue on appeal relates to a method and apparatus for selectively displaying overlapping graphic objects in a data processing system (Spec. 3).

The Illustrative Claim

Claim 1, an illustrative claim, reads as follows:

> 1. A method for performing an operation on a graphic object in a display of overlapping graphic objects in a data processing system, the method comprising the steps of:
>
> storing a model of a graphic object, wherein said model includes an indication of whether said graphic object is a parent or child of another graphic object;
>
> displaying a plurality of overlapping graphic objects to a user;
>
> detecting a selection by the user of a graphics editing operation to be performed on a graphic object;
>
> detecting a position of a pointer with respect to a display of said plurality of overlapping graphic objects;

displaying to a user a list of overlapping graphic objects which coincide with said pointer position and on which said graphics editing operation can be performed;

detecting a selection by the user of one graphic object of said indicated plurality of overlapping graphic objects as a target graphic object without the user changing said pointer position to make said selection;

performing said graphics editing operation on said target graphic object; and

making said target graphic object visible during performance of the graphics editing operation on said target graphic object.

The References

The Examiner relies on the following references as evidence:

Bates	US 5,377,314	Dec. 27, 1994
Brown	US 5,627,959	May 6, 1997
Frank	US 5,651,107	Jul. 22, 1997
Hama	US 5,754,177	May 19, 1998
Keren	US 6,335,733 B1	Jan. 1, 2002

Applicant's Admitted Prior Art (hereinafter "AAPA")

The Rejections

The following rejections are before us for review:

Claims 1-3, 5-10, 15-17, 19-24, 30 and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Hama, Brown, and AAPA.

Claims 4 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Hama, Brown, AAPA, and Keren.

Claims 11 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination Hama, Brown, Bates, and AAPA.

Claims 12-14 and 26-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination Hama, Brown, Bates, Frank and AAPA.

II. ISSUES

Has the Examiner erred in finding that the combination of Hama, Brown, and AAPA teaches or fairly suggests "detecting a selection by the user of one graphic object of said indicated plurality of overlapping graphic objects as a target graphic object without the user changing said pointer position to make said selection", as recited in independent claim 1?

III. PRINCIPLES OF LAW

Obviousness

"Obviousness is a question of law based on underlying findings of fact." *In re Kubin*, 561 F.3d 1351, 1355 (Fed. Cir. 2009). The underlying factual inquiries are: (1) the scope and content of the prior art, (2) the differences between the prior art and the claims at issue, (3) the level of ordinary skill in the pertinent art, and (4) secondary considerations of

nonobviousness. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (citation omitted).

IV. FINDINGS OF FACT

The following findings of fact (FFs) are supported by a preponderance of the evidence.

Hama

1. Hama discloses a means to display a multi-level object by utilizing a pointing device to select different levels of objects (col. 6 ll. 35-67, Figs. 5-8).

V. ANALYSIS

The Appellants have the opportunity on appeal to the Board of Patent Appeals and Interferences (BPAI) to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (citing *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

The Examiner sets forth a detailed explanation of a reasoned conclusion of unpatentability in the Examiner's Answer. Therefore, we look to the Appellants' Brief to show error in the proffered reasoned conclusion. *Id.*

The Common Feature in Claims

Independent claim 1, recites, *inter alia,* "detecting a selection by the user of one graphic object of said indicated plurality of overlapping graphic

objects as a target graphic object without the user changing said pointer position to make said selection". Independent claim 16 contains similar limitations.

35 U.S.C. § 103(a) rejections

With respect to independent claim 1, the Appellants contend that neither Hama nor Brown (nor AAPA) discloses the disputed feature (App. Br. 7). In particular, Appellants argue that "Hama relies on moving a pointer to make selections of objects, which teaches away from Appellant's claimed invention." *Id.*

We agree with the Appellants' contention. We find the Examiner admitted that Hama does not teach the disputed feature (Ans. 11) because Hama moves a pointer to select an object (FF 1). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *See In re Dembiczak*, 175 F.3d at 999. Here, the Examiner merely asserts the disputed feature was well known, but fails to provide any particular findings related to the assertion. The Examiner, in addition, fails to articulate how the well known knowledge is to be used to replace the moving pointer of Hama to render the claimed feature.

Because we agree with at least one of the Appellants' contentions, we, therefore, find that the Examiner has not made a requisite showing of obviousness as required to teach or fairly suggest the invention as recited in claims 1 and 16 by the combination of Hama, Brown, and

AAPA. The rejection of the dependent claims 2-15, 17-27, 30, and 32 contains the same deficiency. The Appellants, thus, have demonstrated error in the Examiner's prima facie case for obviousness of the subject matter of claims 1-27, 30, and 32.

We, therefore, cannot sustain the rejection of claims 1-27, 30, and 32 under 35 U.S.C. § 103.

VI. CONCLUSION

We conclude that the Examiner erred by finding that that the combination of Hama, Brown, and AAPA teaches or fairly suggests "detecting a selection by the user of one graphic object of said indicated plurality of overlapping graphic objects as a target graphic object without the user changing said pointer position to make said selection", as recited in independent claim 1.

VII. ORDER

We reverse the obviousness rejections of claims 1-27, 30, and 32 under 35 U.S.C. § 103(a).

REVERSED

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